

Serial No. 10/612,087

Attorney Docket No. 24-007

**REMARKS**

The applicants appreciate and acknowledge receipt of the initialed copy of the Form PTO-1449 which was filed on June 19, 2007.

Claims 2, 4-7, 9, and 15-23 are pending. Claims 1, 3, 8, 10-14 and 21 have been canceled. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 2, 7, 9, 15, 19, and 22-23 were rejected under 35 USC 102(e) as being anticipated by U.S. Patent Pub. No. 2004/0053044, Moreno (“Moreno”). Claims 4-6, 16-18, and 20 were rejected under 35 USC 103(a) as being unpatentable over Moreno in view of alleged mere change in shape of component. By way of the above amendment, independent claims 2, 4, 7, 16, 17, 19 and 20 will be amended to recite that “the base material and the adhesive layer are made of different materials.” Support for the amendment is located in the application as filed, for example, FIG. 1(a) references 31A, 32A; page 15, line 14-20; and page 16, line 10 to page 17, line 6.

Insofar as the rejections may be applied to the claims as amended, the rejections are respectfully traversed for reasons including the following, which are provided by way of example. The arguments made by applicants in prior amendments are incorporated herein by reference.

The independent claims as amended recite “wherein said adhesive sheet comprises a base material and an adhesive layer, the adhesive layer being disposed between the base material and the release sheet so that the release sheet is releasably adherent to the adhesive sheet portions, wherein the base material and the adhesive layer are made of different materials.”

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Without conceding that Moreno discloses any feature of the present invention, Moreno is directed to an adhesive tape mainly used as a masking tape. The thick adhesive edge makes the adhesive tape useful for masking baseboard, and for masking rough surfaces (paragraphs [0006]-[0008], [0015], [0022]).

The office action asserts that Moreno discloses the invention as claimed. To the contrary, Moreno fails to teach or suggest the invention, as presently claimed, when the claims are considered as a whole. Moreno fails to teach or suggest, for example, "wherein said adhesive sheet comprises a base material and an adhesive layer, ... wherein the base material and the adhesive layer are made of different materials." (See, e.g., claim 2.)

In the office action, the examiner now contends that Moreno teaches adhesive sheet portions (20), a long release sheet (12), and a protective member (18). The office action asserts that Moreno's adhesive sheet (20) comprises a base material and an adhesive layer. To the contrary, Moreno's adhesive sheet (20) fails to teach or suggest that "the base material and the adhesive layer are made of different materials." More particularly, Moreno's inner adhesive strip (Fig. 3, reference 20) in the inner part of the adhesive tape is merely an adhesive. (e.g., paragraph [0018], [0024].<sup>1</sup>

Moreno fails to teach or suggest, for example, these elements recited in independent claims 2, 4, 7, 16, 17, 19 and 20 as amended. It is respectfully submitted therefore that amended claims 2, 4, 7, 16, 17, 19 and 20 are patentable over Moreno.

Furthermore, to maintain the rejection of claims 4-6, 16-18 and 20 under 35 USC 103(a), it is necessary to identify the reason why a person of ordinary skill in the art would have combined allegedly known elements in the manner claimed. *KSR Int'l Co. v. Teleflex, Inc.* No.

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<sup>1</sup> The "optional" use of form strips or films as part of the pressure sensitive adhesive discussed in Moreno paragraph [0025] is not directed to the inner adhesive 20. Instead, Moreno states that "the foam strips may be applied at an edge or edges of a tape ..." Paragraph [0025].

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04-1350 (U.S. Apr. 30, 2007). In the present office action, the examiner admits that Moreno “fails to teach that the protective member is shaped to intrude between the adhesive sheet so as to partially overlap the adhesive sheet.” Then, the examiner summarily concludes that the reason to change the shape of Moreno’s thicker edge member is because “it would have involved a mere change in the shape of the component. A change in shape is found to be within the level of ordinary skill in the art.” It is respectfully submitted that changing a shape merely because shapes can be changed does not constitute a reason why the shape would have been changed, as required by the Supreme Court. The application discusses that the intrusions (sometimes referred to as “bolster portions 302A”) ensure rigidity of the entire laminate sheet when it is wound into a roll, so that deformation of the roll can be suppressed (e.g., page 23, lines 1-7).

The examiner is required to provide a reason why the shape would have been changed. If the examiner cannot provide a reason why the shape of Moreno’s thicker edge would have been changed as recited, the examiner must withdraw the rejection under 35 USC 103(a) of claims 4-6, 16-18, 20 and 23.

The examiner’s attention is drawn to the helpful “Examination Guidelines for Determining Obviousness under 35 U.S.C. 103 in view of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*”, published in Federal Register Vol. 72, No. 195, October 10, 2007, 57526-57535. In the present application, the examiner’s rationale (see *Id.*, page 57529) appears to try to approach the Guidelines’ Rationale (E) “Obvious to Try” or (F) “Known Work In One Field Of Endeavor May Prompt Variations,” because the *prima facie* case is so deficient under Rationales (A) to (D). Under Rationale (E), the examiner is required to articulate (1) a finding that there is a recognized problem in the art; (2) a finding that there are a finite number of identified, predictable solutions; (3) a finding that one of ordinary skill could have pursued the solutions with a reasonable expectation of success; and (4) any other findings to explain the

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obviousness. The examiner's arguments under Rationale (E) are lacking at least articulations (1) and (2). Under Rationale (F), the examiner is required to articulate (1) a finding that the prior art includes an analogous device; (2) a finding that there were design incentives or market forces which would have prompted an adaptation of the known device; (3) a finding that the differences between the invention and the prior art were encompassed in the known variations; (4) a finding that one of ordinary skill, in view of the design incentives, could have implemented the variation, and that the variation would have been predictable; and (5) any other findings to explain the obviousness. The examiner's arguments under Rationale (F) are lacking at least articulations (2), (3), and (4). The rejection of claims 4-6, 16-18 and 20 under 35 USC 103(a) therefore cannot be sustained.

For at least these reasons, the combination of features recited in independent claims 2, 4, 7, 16, 17, 19 and 20, when interpreted as a whole, is submitted to patentably distinguish over the references of record. In addition, Moreno clearly fails to show other recited elements as well.

With respect to the rejected dependent claims, the applicants respectfully submit that these claims are allowable not only for the reasons given above and by virtue of their dependency from the independent claims, but also because of additional features they recite in combination.

The office action remarks that the size and shape of the optical disc is an intended use limitation. By way of the above amendment, claims 15, 17, 22 and 23 will be amended to recite that "wherein said adhesive sheet portions have a size-and-planar form that substantially ~~conforms to a surface of an optical disc shaped~~." Support for the amendment is located in the application as filed, for example, page 20, lines 10-11, page 25, lines 5-6, and FIG. 2. It is submitted that "disc shaped" is sufficiently structural and not directed to an intended use.

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Accordingly, for this additional reason, it is respectfully submitted that claims 15, 17, 22 and 23 are patentable.

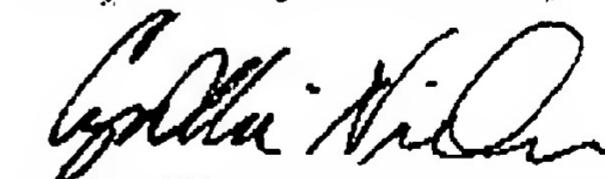
The applicants respectfully submit that, as described above, the cited art does not show or suggest the combination of features recited in the claims. The applicants do not concede that the cited art shows any of the elements recited in the claims. However, the applicants have provided specific examples of elements in the claims that are clearly not present in the cited art.

The applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples applicants have described herein in connection with distinguishing over the cited art as limiting to those specific features in isolation. Rather, for the sake of simplicity, the applicants have provided examples of why the claims described above are distinguishable over the cited references.

In view of the foregoing, the applicants submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,



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